

### **REMARKS**

Claims 1-23 are pending in this application. Claims 1 and 10 are herein amended. Claim 3 is herein cancelled. No new matter has been entered.

The amendment to claim 1 may be supported by the as originally filed specification, for example, original claim 3 and examples 25 and 94, pages 66 and 88.

#### **I. The Rejection under 37 U.S.C. §112**

Claim 10 was rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Applicants respectfully traverse this rejection.

Claim 10 is herein amended for clarity. In light of this amendment, this rejection is now rendered moot. Favorable reconsideration is earnestly solicited.

#### **II. The Rejections under 35 U.S.C. §102**

Claims 1, 2, 8 and 9 were rejected under 35 U.S.C. §102(a) as being allegedly anticipated by Ueda et al (WO 04/076538). Applicants respectfully traverse this rejection.

Claim 1 of the presently claimed invention incorporates the subject matter of originally filed claim 3. Since claim 3 was never rejected as being anticipated by Ueda, the presently claimed invention is novel over Ueda et al. Favorable reconsideration is earnestly solicited.

#### **III. The Rejections under 35 U.S.C. §103 in view of Doi et al.**

Claims 1-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Doi et al (JP 10265636). Applicants respectfully traverse this rejection.

Doi relates to an aqueous resin composition for coating etc. The object and field of Doi's invention are very different from those of the presently claimed invention, which relates to a viscosity modifier for a thermoplastic polyester resin in order to improve moldability such as mold processability and surface properties, that Doi is non-analogous art.

The Examiner asserts that Doi discloses suspension polymer comprising 30-93% by weight of an additional vinyl monomers (0021), such as glycidyl (meth)acrylate or styrene. See Office Action, page 5, lines 4-6. Glycidyl (meth)acrylate is one of many vinyl monomers mentioned, but glycidyl (meth)acrylate is never used in any of the examples of Doi.

Doi discloses that weight average molecular weight of vinyl copolymer (A) is 5,000-50,000 and preferably 8,000-30,000, and that generation of agglomerates and incretion of viscosity are controlled under emulsion polymerization of vinyl monomer mixture (B) according to weight average molecular weight being 50,000 or less. See Doi, paragraph [0023].

The disclosure of Doi, as discussed above, applies to the field of aqueous coating composition. It would be obvious to one of ordinary skill in the art that the disclosure of Doi would prevent the invention of Doi from being applied to the presently claimed invention., which relates to a viscosity modifier from a thermoplastic polyester resin in order to increase melt viscosity of thermoplastic polyester resin signification. See patent application specification, page 4, lines 25-27.

The claimed (meth)acrylate containing an epoxy group and a weight average molecular weight embodiments clearly distinguish the presently claimed invention from the invention of

Doi from the viewpoint of the technical field (non-analogous art) and in both objective and functions.

Doi does not disclose a polymer corresponding to an emulsion polymer as recited in the presently claimed invention. The vinyl monomer mixture (B) is not a polymer but rather a mixture of monomers. In Doi, the vinyl monomer mixture (B) is added into an aqueous liquid containing vinyl copolymer (A) as a monomer state. See Doi, paragraph [0037].

For at least these reasons, the presently claimed invention is not obvious from the disclosure of Doi. Favorable reconsideration is earnestly solicited.

### **III. The Rejections Based on 35 U.S.C. §103 in view of Ueda et al.**

Claims 1, 2, 6-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ueda et al (WO 03/093353). Applicants respectfully traverse this rejection.

It was asserted that Ueda discloses glycidyl (meth)acrylate. However, glycidyl (meth)acrylate is only one monomer mentioned in a very long list of monomers in Ueda. Furthermore, Ueda does not disclose any examples where a vinyl monomer is used for a suspension polymer.

In addition, Ueda does not disclose a weight average molecular weight of the polymer particles.

For at least these reasons, the presently claimed invention is not obvious from the disclosure of Ueda. Favorable reconsideration is earnestly solicited.

**IV. The Rejections Based on 35 U.S.C. §103 in view of Ueda et al and Doi et al.**

Claims 3-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ueda et al (WO 03/093353), as applied to claim 1 above, and further in view of Doi et al (JP 10265636). Applicants respectfully traverse this rejection.

As discussed above, individually Ueda and Doi fail to render the presently claimed invention obvious. The mere combination of the cited references fails to render the presently claimed invention obvious since the deficiencies of each reference are not overcome by the proposed combined reading.

Favorable reconsideration is earnestly solicited.

**V. The Rejections Based on 35 U.S.C. §103 in view of Nakada et al. and Ueda et al.**

Claims 1, 2, 6-9, 11, 14, 15, 17, 18, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakada et al (JP 2001-098145), in view of Ueda et al (WO 03/093353). Applicants respectfully traverse this rejection.

The invention of Nakada is directed towards a thermoplastic polyester resin composition containing mainly a thermoplastic polyester resin and a small amount of component B-1.

Nakada discloses that component B-1 comprises a glycidyl (meth)acrylate. See Nakada paragraph [0041]. However, component B-1 is added directly into the thermoplastic polyester resin. See Nakada, paragraph [0042]. There is no suspension polymer coated with an emulsion

polymer, as recited in the presently claimed invention. Thus, Nakada does not disclose (meth)acrylate containing an epoxy group of the present invention.

Furthermore, Nakada does not disclose an weight average molecular weight of the polymer particles.

As discussed above, Ueda does not render the presently claimed invention obvious either. Ueda does not disclose a weight average molecular weight of the polymer particles. Ueda may disclose glycidyl (meth)acrylate as one of many vinyl monomers, but does not disclose any examples with a vinyl monomer.

The proposed combined reading of Nakada in view of Ueda does not render the presently claimed invention obvious because the deficiencies of each reference are not overcome by the proposed combined reading of the references. Thus, the presently claimed invention is not obvious. Favorable reconsideration is earnestly solicited.

**VI. The Rejections Based on 35 U.S.C. §103 in view of Nakada et al, and Ueda et al and Doi et al.**

Claims 3-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Nakada et al (JP 2001-098145), and Ueda et al (WO 03/093353) as applied to claim 1 above, and further in view of Doi et al (JP 10265636). Applicants respectfully traverse this rejection.

As discussed above, individually Nakada, Ueda and Doi fail to render the presently claimed invention obvious. The mere combination of the cited references fails to render the

presently claimed invention obvious since the deficiencies of each reference are not overcome by the proposed combined reading.

Favorable reconsideration is earnestly solicited.

**VII. The Rejections Based on 35 U.S.C. §103 in view of Nakada et al, Ueda et al and Meyer et al.**

Claims 12 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Nakada et al (JP 2001-098145), and Ueda et al (WO 03/093353) as applied to claim 1 above, and further in view of Meyer et al (U.S. 5,854,346). Applicants respectfully traverse this rejection.

As discussed above, individually Nakada and Ueda fail to render the presently claimed invention obvious. The mere combination of Nakada and Ueda with Meyer fails to render the presently claimed invention obvious since the deficiencies of each reference are not overcome by the proposed combined reading.

Favorable reconsideration is earnestly solicited.

**VIII. The Rejections Based on 35 U.S.C. §103 in view of Nakada et al, Ueda et al and Yoshida et al.**

Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Nakada et al (JP 2001-098145), and Ueda et al (WO 03/093353) as applied to claim 1 above, and further in view of Yoshida et al (U.S. 6,235,825). Applicants respectfully traverse this rejection.

As discussed above, individually Nakada and Ueda fail to render the presently claimed invention obvious. The mere combination of Nakada and Ueda with Yoshida fails to render the presently claimed invention obvious since the deficiencies of each reference are not overcome by the proposed combined reading.

Favorable reconsideration is earnestly solicited.

**VIII. The Rejections Based on 35 U.S.C. §103 in view of Nakada et al, Ueda et al and Kuroda et al.**

Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Nakada et al (JP 2001-098145) and Ueda et al (WO 03/093353) as applied to claim 1 above, and further in view of Kuroda et al (U.S. 5,786,408). Applicants respectfully traverse this rejection.

As discussed above, individually Nakada and Ueda fail to render the presently claimed invention obvious. The mere combination of Nakada and Ueda with Kuroda fails to render the presently claimed invention obvious since the deficiencies of each reference are not overcome by the proposed combined reading.

Favorable reconsideration is earnestly solicited.

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that the rejections under 35 U.S.C. §112, 35 U.S.C. §102 and 35 U.S.C. §103 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

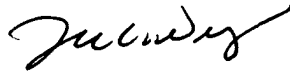
Application No.: 10/599,884  
Art Unit: 1796

Amendment under 37 C.F.R. §1.111  
Attorney Docket No.: 063129

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,  
**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**



Lee C. Wright  
Attorney for Applicants  
Registration No. 41,441  
Telephone: (202) 822-1100  
Facsimile: (202) 822-1111

LCW/BKM/bam